UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,433	07/03/2003	Leonel Yanez Martinez	MX/JFC-Serv-001	5111

7590 06/19/2006

Carmen Pili Ekstrom
727 Sunshine Dr.
Los Altos, CA 94024

EXAMINER	
MAYO III, WILLIAM H	

ART UNIT	PAPER NUMBER
2831	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

H·A

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/613,433
Filing Date: July 03, 2003
Appellant(s): MARTINEZ ET AL.

Carmen Pili Ekstrom
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 23, 2006 appealing from the Office action mailed May 19, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on August 10, 2005, requesting the withdrawal of the restriction has been considered and entered.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

a) Claims 11-13, 16-18, 20, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (Pat Num 5,486,648, herein referred to as Chan) in view of Goehlich (Pat Num 6,784,371).

b) Claims 14-15, 19, 21-22, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (Pat Num 5,486,648) in view of Goehlich (Pat Num 6,784,371, herein referred to as modified Chan), as applied to claims 11 & 18 above, further in view of Belli et al (Pat Num 6,455,769, herein referred to as Belli).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,486,648	CHAN et al	01-1996
6,784,371	GOEHLICH	08-2004
6,455,769	BELLI et al	09-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

a) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Appellant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

c) Claims 11-13, 16-18, 20, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan et al (Pat Num 5,486,648, herein referred to as Chan) in view of Goehlich (Pat Num 6,784,371). Chan discloses a dry water resistant coaxial cable (Figs 1-8), which provides improved protection against the migration of water (Col 1, lines 5-16). With respect to claim 11, Chan discloses a cable (Fig 3) comprising a metal core conductor element (1), a dielectric element (2-4) around the core conductor (1)

which is based on three layers, comprising a first layer (2) comprising a polymer mixed with an adhesive component and applied to the conductor (1) as an uniform layer (Col 5, lines 17-26), a second layer (3) comprising a cellular expansion polymer (i.e. XLPE) on the first layer (2, Col 5, lines 15-25), and a third layer (4) comprising a reinforcement layer on the second layer (3, Col 5, lines 15-25), a second external conductor (6) surrounding the dielectric element (6), a second conductor element (5a) on the second external conductor (6) comprising a water penetration protective element (i.e. swellable yarn) and a protective element (7) surrounding the second conductor element (5a, Col 5, lines 36-46). With respect to claim 12, Chan disclose that the metal core conductor (1) may be made of copper or aluminum (Col 5, lines 11-13). With respect to claim 13, Chan discloses that the first layer and the third layer (2 & 4) may comprise a material such as (i.e. XLPE, low density polyethylene, Col 4, lines 19-25), wherein the layers are thin, continuous and homogeneous (Col 4, lines 19-25). With respect to claim 16, Chan discloses that the second external conductor (6) may be made of copper and aluminum (Col 5, lines 28-30). With respect to claim 17, Chan discloses that the water penetration protective element (5a) may comprise water swellable fibers, such as polyester (Col 3, lines 64-67). With respect to claim 18, Chan discloses that the protective cover (7) may be made of low and medium density polyethyelene (Col 5, lines 36-40). With respect to claim 23, Chan discloses that the water penetration protective element (5a) may comprise a swellable tape (5d as shown in Fig 8), which is helically wound on the second conductor (6, Fig 8). With respect to claim 24, Chan discloses that the water penetration protective element (5a) has an absorption speed (Col 4, lines 14-18). With

respect to claim 25, Chan discloses that the protective cover (7) may be a medium density polyethylene (i.e. polyethylene is black in color, Col 5, lines 36-40), wherein the protective cover (7) has an outside diameter (Fig 2).

However, Chan doesn't necessarily disclose the first layer comprising an adhesive (claim 11), nor the adhesive being selected from the group consisting of vinyl adhesive, acrylic adhesive, and combination thereof (claim 13), nor the adhesive being selected from the group consisting of ethylene acrylate acid, ethylene vinyl acid, and combinations thereof (claim 20), nor the absorption speed being 15ml/g per minute and absorption capacity of more than 30ml/g (claim 24).

Goehlich teaches a cable (Figs 1-4) comprising a cable core being surrounded by a plurality of insulating layers which overcomes the shortcoming of the prior art cables by preventing water intrusion resulting from a damage outer sheath to travel longitudinally thereby eliminating the possibility of the internal components (Col 1, lines 1-6 & 28-37). Specifically, with respect to claim 11, Goehlich teaches a cable (Fig 1) comprising a cable core (1), which is surrounded by a plurality of insulation layers (5a & 5b), wherein the insulation layers (5a & 5b) are formed as thin film layers (Col 7, lines 22-34), and comprise an adhesive component (Col 5, lines 8-20). With respect to claims 13 & 20, Goehlich teaches that the adhesive component may be selected from ethylene acrylate acid (Col 5, lines 8-20).

With respect to claims 11, 13, & 20, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the insulation layers of Chan to comprise the adhesive component configuration as taught

by Goehlich because Goehlich teaches that such a configuration overcomes the shortcoming of the prior art cables by preventing water intrusion resulting from a damage outer sheath to travel longitudinally thereby eliminating the possibility of the internal components (Col 1, lines 1-6 & 28-37).

With respect to claim 24, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the cable of modified Chan to comprise the absorption speed being 15ml/g per minute and absorption capacity of more than 30ml/g, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233.*

d) Claims 14-15, 19, 21-22, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chan (Pat Num 5,486,648) in view of Goehlich (Pat Num 6,784,371, herein referred to as modified Chan), as applied to claims 11 & 18 above, further in view of Belli et al (Pat Num 6,455,769, herein referred to as Belli). Modified Chan discloses a dry water resistant coaxial cable (Figs 1-8, see Chan reference), which provides improved protection against the migration of water (Col 1, lines 5-16). Specifically, with respect to claim 14, modified Chan discloses that the second layer (3) may be made of low-density polyethylene. With respect to claim 21, modified Chan discloses that the second conductor element (3) is applied onto the core conductor (1) and is capable of providing a better water tightness to the swellable dielectric element (5a) and superficial appearance (Col 4, lines 19-35). With respect to claim 22, modified Chan discloses that

the second external conductor (6) may be made of aluminum or copper (Col 5, lines 28-30).

Modified Chan doesn't necessarily disclose the second layer comprising a swelling agent (claim 14), nor the swelling agent being selected from the group consisting of azodicarbonamide, p-toluene, sulphonyl hydrazide, 5-phynyl tetrazol and combinations, thereof (claim 15), nor the diameter of the second layer being 13.0mm $\pm$ 0.10mm (claim 21), nor the outer conductor being a material formed as a cylindrical pipe which can be longitudinally welded, extruded, or the edges overlapped having an external conductor thickness of at least 0.34mm and a diameter of 13.7mm $\pm$ 0.10mm (claim 22), nor the diameter of the protective cover being 15.5mm $\pm$ 0.10mm with about 0.67mm $\pm$ 0.02mm thickness (claim 26), nor the cable comprising an antioxidants (claim 27).

Belli teaches a cable (Fig 1) comprising a cable core which overcomes the shortcomings of the prior art cables by effectively addressing both the problem of avoiding penetration and propagation of moisture and/or water inside the cable core, the problem of possible deformations or breakages of the metallic shield due to cable thermal cycles, while maintaining a proper electrical contact between the metal shield and the cable core (Cols 2-3, lines 65-68 & 1-4). Specifically, with respect to claim 14, Belli teaches a cable (Fig 1) comprising a cable core (1), a plurality of insulation layers (2-4), a metallic shielding layer (6) and an outer jacket layer (7), wherein the second insulation layer (3) may contain an expanding agent (Col 7, lines 1-4). With respect to claim 15, Belli teaches that the second insulation layer (3) may comprise a swelling

agent which may be azodicarbonamide, or p-toluene, sulphonyl hydrazide (Col 7, lines 5-10). With respect to claim 21, Belli teaches that the diameter of the insulation layers may be 14mm (Col 9, line 54). With respect to claim 22, Belli teaches that the outer conductor (6) may be a material formed as a cylindrical pipe (i.e. metallic tube) which can be longitudinally welded or the edges overlapped Col 4, lines 55-60), wherein the shield (6) may have an external conductor thickness of at least 0.2mm and a diameter of 14.2mm (Col 10, lines 12-15). With respect to claim 26, Belli teaches that the cable (Fig 1) has a diameter (Fig 2). With respect to claim 27, Belli teaches that the insulation layers (2-5) of the cable (Fig 1) may comprise an antioxidant (in Irganox (Col 10, lines 60-65).

With respect to claims 14-15 and 27, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the cable of modified Chan to comprise the a swellable agent configuration as taught by Belli because Belli teaches that such a configuration overcomes the shortcomings of the prior art cables by effectively addressing both the problem of avoiding penetration and propagation of moisture and/or water inside the cable core, the problem of possible deformations or breakages of the metallic shield due to cable thermal cycles, while maintaining a proper electrical contact between the metal shield and the cable core (Cols 2-3, lines 65-68 & 1-4).

With respect to claims 21-22 & 26, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the cable of modified Chan to comprise the diameter of the second layer to be 13.0mm $\pm$ 0.10mm, the outer

conductor to have an thickness of at least 0.34 mm and a diameter of 13.7mm ± 0.10mm and the protective cover to have an thickness 15.5 mm ± 0.10 mm with about 0.67mm ± 0.02 mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller, 105 USPQ 233.*

(10) Response to Argument

Appellant's arguments filed March 23, 2006 have been fully considered but they are not persuasive. Specifically, the appellant argues the following:

A) The examiner has failed to establish a proper prima facie case of obviousness, because there are no references in the prior art that taken individually or together disclose all of the elements of the present invention, motivate, or suggest the present invention or provide reasonable expectation of success.

B) There is no disclosure or suggestion in Chan to utilize adhesives and other layers such as second external conductor and second conductor of the present invention and the examiner has not shown any prior art that provides motivation or suggestion to incorporate the adhesive in Chan.

C) There is no motivation or suggestion in the prior art to combine the Chan and Goehlich references to arrive at the presently claimed invention because one would not have been able to do so with a reasonable

expectation that the cable of Chan will function effectively without significantly affecting the other components contained therein.

D) There is no motivation or suggestion in the prior art to combine the Chan, Goehlich, and Belli references to arrive at the presently claimed invention.

E) The cited art fails to provide a proper motivation or suggestion because the invention contains elements nowhere found or suggested in the prior art.

F) The cited art fails to address the problem with which the presently claimed invention is concerned.

G) The examiner has chosen to improperly ignore the Appellant's limitation in the presently claimed process.

H) The examiner has engaged in improper hindsight, specifically, improperly utilized the Appellant's own teaching to construct the obviousness rejection.

I) Belli teaches away from the claimed invention and therefore fails to provide a proper motivation for combining with modified Chan.

With respect to arguments A & B, the examiner respectfully traverses. Firstly, it has been held that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Clearly, the examiner has conceded that Chan doesn't disclose the first layer comprising an adhesive, specifically, an adhesive being selected from the group consisting of vinyl adhesive, acrylic adhesive, and combination thereof or ethylene acrylate acid, ethylene vinyl acid, and combinations thereof having an absorption speed being 15ml/g per minute and absorption capacity of more than 30ml/g. The examiner also recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Goehlich teaches a cable (Figs 1-4) comprising a cable core being surrounded by a plurality of insulating layers which overcomes the shortcoming of the prior art cables by preventing water intrusion resulting from a damage outer sheath to travel longitudinally thereby eliminating the possibility of the internal components (Col 1, lines 1-6 & 28-37). Based on the teaching of Goehlich, there clearly exist a motivation to modify Chan with the adhesives of Goehlich, since Chan is also concerned with preventing against the migration of water (Col 1, lines 5-16). Thirdly, all of the claimed subject matter is disclosed in the combination of Chan and Goehlich. The MPEP clearly states that

ESTABLISHING A PRIMA FACIE CASE OF OBVIOUSNESS

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

As explained above, there clearly exist a motivation to combine the teaching of Chan and Goehlich as detailed above, because both are analogous art (data cables) and are concerned with the same problem solving area (prevention of water migration). Secondly, there exist a reasonable amount of expectation of success, since they both are data cable concerned with prevention of water migration. Thirdly, all of the claimed limitations are taught in the combination of the reference, and therefore a proper prima facie case of obviousness has been established.

The appellant also argues that none of the patents cited are analogous art, as an argument for supporting arguments A & B. The examiner respectfully traverses this argument also. The MPEP is clear what constitutes analogous art. Specifically, the MPEP 2141.01 states:

TO RELY ON A REFERENCE UNDER 35 U.S.C. 103, IT MUST BE ANALOGOUS PRIOR ART

The examiner must determine what is "analogous prior art" for the purpose of analyzing the obviousness of the subject matter at issue. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with

which the inventor was concerned." In re Oetiker, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem."); Wang Laboratories Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993); and State Contracting & Eng 'g Corp. v. Condotte America, Inc., 346 F.3d 1057, 1069, 68 USPQ2d 1481, 1490 (Fed. Cir. 2003) (where the general scope of a reference is outside the pertinent field of endeavor, the reference may be considered analogous art if subject matter disclosed therein is relevant to the particular problem with which the inventor is involved).

Clearly, all of the cited references disclose that the cable may be utilized as a power cables or communication cables, which is in the same field of endeavor as appellant's (see Appellant's Background of Invention section, Pages 1-2). Specifically, Chan discloses in Column 1, lines 5-8,

> This invention relates to electrical power cables which have concentric neutral wires (CN wires) applied helically over the cable core as a metallic ground shield which is then covered by a protective polymeric jacket. More particularly,

Goehlich discloses in Column 3, lines 20-22,

> Such cable according to the present invention, for example may be a power cable, a copper telecom cable, and a fibre optical cable.

Secondly, all of the cited references are concerned with the same problem solving area as the appellant's which is to prevent the entry of water into the cable which can cause the cable to fail (see Appellant's Background of Invention section, Pages 1-2).

Specifically, Chan discloses in Column 1, lines 8-15,

> covered by a protective polymeric jacket. More particularly, the invention relates to an improved protection against migration of water in such power cables by providing suitable continuous, elongated water swellable elements, such as yarns, filaments, strands or strips in contact with the CN wires and so disposed in relation to said CN wires as to block the passage of water within the cable in the longitudinal direction.

Goehlich discloses in Column 1, lines 18-27,

> In such a cable conditions can occur in which substances like water intrude through the partially damaged outer sheath and such substance travels between the inner cable sheath and outer cable sheath in longitudinal direction leading to damage of the cable by chemical and electrochemical effects in a much larger cable section than the section of the partial damage of the outer sheath and inaccurate substance intrusion measurements. The invention particularly addresses these problems in order to limit damaged areas and to increase the measurement accuracy and lifetime of the cable.

To be considered analogous art only one of the two guidelines have to exist, however in this case both guidelines exist to establish that Chan and Goehlich are analogous art. In light of the above comments, the examiner willfully submits that the 35 USC 103(a) rejection is proper and just.

With respect to argument C, the examiner respectfully traverses. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

With respect to arguments D & I, the examiner respectfully traverses. It should be stated that modified Chan teaches all except the second layer comprising a swelling agent (claim 14), nor the swelling agent being selected from the group consisting of

azodicarbonamide, p-toluene, sulphonyl hydrazide, 5-phynyl tetrazol and combinations, thereof (claim 15), nor the diameter of the second layer being 13.0mm ± 0.10mm (claim 21), nor the outer conductor being a material formed as a cylindrical pipe which can be longitudinally welded, extruded, or the edges overlapped having an external conductor thickness of at least 0.34mm and a diameter of 13.7mm ± 0.10mm (claim 22), nor the diameter of the protective cover being 15.5mm ± 0.10mm with about 0.67mm ± 0.02mm thickness (claim 26), nor the cable comprising an antioxidants (claim 27). Belli is only relied on for it's teaching of utilizing a specific adhesive for providing a waterproof cable. Specifically, the examiner recognizes that Belli teaches the usage of filler materials, which is completely opposite of what the appellant is claiming. However, it has been held that patents are relevant for all they disclose. Specifically,

"The use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are pad of the literature of the art, relevant for all they contain." In re Heck, 699 F.2d 1331 , 1332- 33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting In re Lemelson, 397 F.2d 1006, 1009, 158 USPQ 275, 277 (CCPA 1968))."

The courts have been consistent that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including non-preferred embodiments. See Merck & Co. v. Biocraft Laboratories, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also Celeritas Technologies Ltd. v. Rockwell International Corp., 150 F.3d 1354, 1361 , 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998) (The court held that the prior art anticipated the claims even though it taught away from the claimed invention. "The fact that a modem with a single carrier data signal is shown to be less than optimal does not vitiate the fact that it is disclosed").

In this case, Belli is only disclose for it's telling of various materials known and being utilized in the cables, when preventing water penetration is an objective. Given

the above stated guidelines, the examiner is proper to rely on Belli for it's teaching of the various materials and the dimension of such layers and that the 35 USC 103(a) utilizing Belli is proper and just. Belli, also is analogous art. Specifically, Belli discloses in Col 1, lines 12-15,

> The present invention relates to an electrical cable, in particular for medium- or high-voltage power transmission or distribution, having a semiconductive water-blocking expanded layer. In the present description, the term

Belli discloses in Col 1, lines 12-15,

> cable and 'the metal shield. Moreover, the presence of the water-swellable material dispersed into the expanded layer is able to effectively block moisture and/or water, thus avoiding the use of water-swellable tapes or of free water-swellable powders.

Based on the above comments, it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the cable of modified Chan to comprise the a swellable agent and various insulation material configuration as taught by Belli because Belli teaches that such a configuration overcomes the shortcomings of the prior art cables by effectively addressing both the problem of avoiding penetration and propagation of moisture and/or water inside the cable core, the problem of possible deformations or breakages of the metallic shield due to cable thermal cycles, while maintaining a proper electrical contact between the metal shield and the cable core (Cols 2-3, lines 65-68 & 1-4).

With respect to arguments E & F, the examiner respectfully traverses. It has been established above, that there exist a proper motivation for combining the references. (see rebuttals to arguments A-E) and that the 35 USC 103(a) rejections are proper and just and that all claimed elements have been addressed. Secondly, it

has also been established that the claimed invention and the prior art cited, all disclose the same problem solving area, which is to prevent water penetration into a cable. While the prior art may not disclose all of the problem solving areas of the appellant, it doesn't have to. Specifically, it has been held that the fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Therefore, the examiner willfully submits that the 35 USC 103(a) rejections are proper and just.

With respect to argument G, the examiner respectfully traverses. Firstly, it has been held that process limitations, recited in a product claim, doesn't add any additional structure because it has been held that the presence of process limitations in product claims, in which the product doesn't otherwise patentably distinguish over the prior art, cannot impart patentability to that product. As long as the product of the prior art, is capable of being made by that process, that particular claim limitation is met. Secondly, as stated above, with respect to claim 22, Belli teaches that the outer conductor (6) may be a material formed as a cylindrical pipe (i.e. metallic tube) which can be longitudinally welded or the edges overlapped Col 4, lines 55-60), wherein the shield (6) may have an external conductor thickness of at least 0.2mm and a diameter of 14.2mm (Col 10, lines 12-15). Therefore, the examiner willfully submits that the 35 USC 103(a) rejection of claims 22-23 is proper and just.

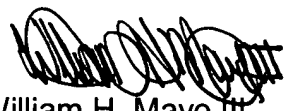
With respect to argument H, the examiner respectfully traverses. It must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

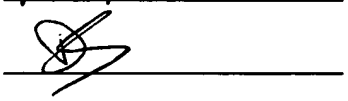
Respectfully submitted,



William H. Mayo III
Primary Examiner 2831

Conferees:

Dean Reichard (SPE) 

Darren Schuberg (SPE) 

William H. Mayo III (Primary Examiner)